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May 10, 2001

THIS DISPOSITION
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Paper No. 10
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re East Penn Manufacturing Company, Inc.

Serial No. 75/431,354

Zachary T. Wobensmith, III, Esq. for East Penn
Manufacturing Company, Inc.

Julie A. Watson, Trademark Examining Attorney, Law Office
104 (Sidney I. Moskowitz, Managing Attorney).

Before Hairston, Chapman and Rogers, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On February 9, 1998, East Penn Manufacturing Company,
Inc. filed an application to register on the Principal
Register the mark shown below

for goods identified, as amended, as "spark plug wire sets"
in International Class 7; "hand-operated battery post and
terminal cleaner tools in the nature of rotatable metal
brushes which are engaged with the posts and terminals and
hand-operated battery lifters" in International Class 8,

and "storage batteries, electric battery cables, emergency jumper cables, antifreeze testers which measure the specific gravity of the vehicles antifreeze mixture, battery terminals and battery holddown straps for vehicles" in International Class 9. Applicant claimed dates of first use and first use in commerce of April 15, 1976 for goods in each class.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on its identified goods, so resembles the registered mark LYNX for "automobiles and structural parts thereof" in International Class 12,¹ as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, and an oral hearing was held before this Board on May 10, 2001.

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

¹ Registration No. 1,163,630, issued August 4, 1981 to Ford Motor Company, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use is June 1965.

The involved marks are virtually identical. This fact "weighs heavily against applicant." In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 Fed. Cir. 1984). Indeed, the fact that an applicant has selected the identical mark of a registrant weighs so heavily against the applicant that applicant's use of the mark on "goods...[which] are not competitive or intrinsically related [to registrant's goods]...can [still] lead to the assumption that there is a common source." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). "The greater the similarity in the marks, the lesser the similarity required in the goods or services of the parties to support a finding of likelihood of confusion." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:20.1 (4th ed. 2000).

We turn to a consideration of the cited registrant's goods and applicant's goods. Applicant's position is that its goods (e.g., storage batteries, battery cables, jumper cables and hand-operated battery post and terminal cleaner tools) and the cited registrant's "automobiles and structural parts thereof" do not overlap because registrant's automobile parts are "structural" parts of the automobile, whereas applicant's goods are "accessories" for

the automobile²; that the respective goods travel in different channels of trade (i.e., registrant's goods are sold "by franchised dealers" and applicant's goods are sold "by other retailers" - brief, p. 3); and that registrant's goods are expensive and are purchased only after careful comparison and study by the consumer.

The Examining Attorney argues that the parties' goods are closely related and travel in the same channels of trade to the same purchasers. In support of her position as to the relatedness of the respective goods, the Examining Attorney submitted a few third-party registrations³ to demonstrate the close relationship between "automobiles and structural parts thereof" and products such as batteries, spark plugs, and the like, by showing that a single entity has adopted a single mark for such goods.

While third-party registrations are not evidence of commercial use of the marks shown therein, or that the

² We note that applicant presented no evidence of any automobile industry standard defining "structural parts" vis-a-vis "accessories"; and we take judicial notice of the relevant definition of "structural" from The American Heritage Dictionary which reads as follows: "2. Used in or necessary to construction." Items such as tires, batteries and spark plugs are certainly used in and are necessary to the construction of an automobile as discussed later in this decision.

³ We considered only those third-party registrations which issued based on a claim of use.

public is familiar with them, nonetheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

Moreover, it is well settled that goods need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods or services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Also, it has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the

Board is constrained to compare the goods as identified in the application with the goods as identified in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, some of applicant's goods, such as spark plug wire sets, storage batteries, electric battery cables and battery terminals and registrant's automobiles and structural parts thereof are clearly complementary, closely related products. The vehicle parts sold by applicant are obviously necessary for the vehicle to operate. See *In re Jeep Corp.*, 222 USPQ 333, 334 (TTAB 1984), and cases cited therein; and *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 343 (TTAB 1980). Likewise, applicant's hand-operated tools used in working on vehicles are also products which are commercially closely related to automobiles and parts therefor. See *Permatex Company, Inc. v. California Tube Products, Inc.*, 175 USPQ 764 (TTAB 1972).

Applicant argues that registrant's goods are sold through franchised dealers while its goods are sold by "other retailers." However, applicant provided no evidence

regarding this argument. Moreover, applicant included no restriction to trade channels or purchasers in its identification of goods. Thus, the Board must consider that the parties' respective goods could be offered and sold to the same classes of purchasers through all normal channels of trade. See *Canadian Imperial Bank v. Wells Fargo Bank*, supra; *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

With regard to applicant's argument that registrant's goods are expensive, we agree only to the extent that automobiles are expensive products. There is no evidence of record that the structural parts/accessories involved herein are expensive.

Applicant states that "no instances of confusion have come to Applicant's attention during its over twenty three year use of the 'LYNX' mark." (Brief, p. 5). However, there is no evidence of the parties' respective sales of the involved goods sold under the mark LYNX, and there is no information from registrant on the issue of actual confusion. This factor is not persuasive in the overall balancing of the du Pont factors in this case.

Applicant argues that the USPTO already determined that there was no likelihood of confusion by registering the cited mark in 1981 over applicant's then-valid 1977

registration⁴ for the mark LYNX for similar goods as those in applicant's current application. However, the issue before us now is whether applicant's mark LYNX for its goods (various vehicle parts and tools) is likely to cause confusion with the cited mark LYNX for automobiles and structural parts thereof, not whether the Examining Attorney who examined the application which issued as the cited registration acted appropriately, or whether the Examining Attorney did or did not have any doubt on the issue of likelihood of confusion.

Neither the Board, nor any Court is bound by prior decisions of Trademark Examining Attorneys, and each case must be decided on its own merits, on the basis of the record therein. See *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001). See also, *In re Nett Designs Inc.*, ___ F.3d ___, 57 USPQ2d 1564 (Fed. Cir. 2001). We can only speculate as to why the cited registration issued over applicant's now-cancelled registration.

Applicant also argues that the USPTO "is applying a different standard for approval of new applications compared to renewal of existing registrations" (brief, p.

⁴ Registration No. 1,068,438, issued June 28, 1977, Section 8 accepted, Section 15 acknowledged. This registration was cancelled in 1998 for failure to file a Section 9 renewal.

4), specifically asserting that if applicant had timely filed a Section 9 renewal, its previous registration would have been renewed, and the Examining Attorney improperly ignored this fact. We disagree, and find that it was proper for the Examining Attorney not to have given any weight to this argument. Post Registration Branch paralegals conduct an administrative review of renewals for compliance with the requirements of Section 9 of the **Trademark Act**. They do not consider the issue of likelihood of confusion. However, the review by Examining Attorneys of newly-filed applications obviously includes, inter alia, examination of the issue of likelihood of confusion under Section 2(d) of the **Trademark Act**.

Finally, applicant requests (brief, p. 7) that the Board take judicial notice of the fact that the cited registrant has "abandoned the 'LYNX' trademark Reg. No. 1,163,630." Applicant's request is denied because that is not a matter appropriate for judicial notice. See Fed. R. Evid. 201, and TBMP §712.01. Applicant could have filed a petition to cancel the cited registration pursuant to Section 14 of the **Trademark Act**.

Based on the virtually identical marks, the close relationship of the parties' respective goods, and the identical trade channels and purchasers, we find that there

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is a likelihood that the purchasing public would be confused as to the source of the goods when applicant uses LYNX as a mark for its identified goods.

Decision: The refusal to register under Section 2(d) is affirmed.